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09/615,351

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Wlodek W. Zadrozny

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07/28/2004

EXAMINER

MOONEYHAM, JANICE A

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ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/615,351

Applicant(s)

ZADROZNY ET AL.

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 46-56, 82 and 83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 46-56, and 82-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on April 26, 2004, wherein:  
  
Claims 1-23, 46-56, and 82-83 are pending in this application;  
  
Claims 1-10, 13-19, 21, 23, 46-56, and 82-83 are currently amended;  
  
No claims have been added;  
  
No claims have been canceled.

#### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 101***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-2, 10-13 and 46-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In the present case, claims 1-2, 10-13 and 46-51 only recites an abstract idea as stated in the first Office Action.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is for developing inventions by a plurality of inventors, said inventors using a plurality of computing devices connected to a network. Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-23, 46-56, and 82-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1, 14, 46, 52, and 82, the applicant identifies the invention in the preamble as being a method or system for "developing inventions by a plurality of inventors." However, the claim language does not develop an invention. The claim language identifies a method or system  
° for creating a list, receiving information, creating qualifications or criteria and performing a

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search to match, organize, or sort the list. The invention does not accomplish what the applicant states that it is supposed to do. Claims 2-13 read on claim 1, Claims 15-23 read on claim 14, claims 47-51 read on claim 46, claim 53-56 read on claim 52, and claim 83 reads on claim 82.

4. Claims 1-23, 46-56, and 82-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claims recite two concepts or inventions. The preamble identifies a method or system for developing an invention while the claim language is to a system or method for searching a database based on qualifications or criteria.

5. Claims 1-13, and 46-56 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps and elements, such omission amounting to a gap between the steps and elements. See MPEP § 2172.01. The omitted steps or elements are:

How is the inventive idea developed? What creates the subscriber list, what creates the proposal, and what creates the qualifications? How are the subscribers contacted? How is the forum provided and how is the communication performed? How is the forum secured? How is the access provided to the secure forum? How is the non-subscriber criteria established? How is the confidentiality level established? How is a fee obtained? How is the message sent from the server? How does one receive the message?

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-13, 46-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Atcheson et al. (US Patent 5,583,763) (hereinafter referred to Atcheson).

Atcheson discloses a method comprising creating a list (database includes a plurality of datafiles containing a plurality of preferences, Fig. 4.(300), (302)), receiving information, creating criteria or qualifications (target user inputs signal to indicate a set of preferences), and searching or matching based on the criteria (database is searched to determine the number of user preferences that match preferences in the datafiles) (Fig. 3, 4 col. 2, lines 16-27)

Atcheson does not disclose developing an invention, a subscriber list, receiving a proposal, or creating a pool of co-inventors. The fact that the method for searching a database based on the qualifications is for developing an invention is non-functional descriptive material and is given little patentable weight. The fact that the list is a subscriber list, that the information is a proposal, and that the qualifications are for co-inventors or that the match list is identified as a co-inventor pool is also non-functional descriptive material and carries little patentable weight. They add little, if anything, to the claimed steps and thus do not serve as a limitation on the claims to distinguish over the prior art.

The dependent claims are rejected for incorporating the defects from the parent claim by their dependency.

7. Claims 14-23 and 82-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Atcheson.

Atcheson discloses a network (100) used to transfer information, a server (inherent in a network system), a terminal for transmitting information (108), a database for storing list and records (Fig. 2, fig. 3 (210), fig. 4(300, 301).

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The fact that the system is used by inventors, co-inventors, for developing an inventive idea or that the information is a patent proposal is all non-functional descriptive material and is given little patentable weight.

The dependent claims are rejected for incorporating the defects from the parent claim by their dependency.

### ***Response to Arguments***

8. Applicant's arguments filed on April 26, 2004 have been fully considered but they are not persuasive.

The applicant argues that Atcheson does not disclose a method or system for developing inventions by a plurality of inventors. As stated in the first Office Action, the applicant's invention does not teach or describe a method or system for developing inventions by a plurality of inventors either. The applicant's invention is a method and system for creating a list, receiving information, creating criteria or qualifications, and searching or matching based on the criteria. As stated in the first Office Action, the list being a subscriber list, the information being a proposal, and the pool being co-inventors has been determined to be non-functional descriptive material. Since the particular data as recited has been determined to be non-functional descriptive material, it does not need to be taught by the prior art. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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